REMARKS

Claims 38-48 have been amended to overcome the formal objection raised by the Examiner. Claims 1-37 and 49-54 are presented without amendment. It is again respectfully requested that the requirement for restriction be withdrawn for reasons previously advanced and claims 1-37 and 49-54 allowed.

Claims 38-48 stood rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Regarding claim 38, it is said that Applicant should clarify the structure of the shielding device and its arrangement in order to electrically shield said first core portion from said second core portion. Claim 38 has been amended to recite the shielding device located between the first core portion and the second core portion. Accordingly, withdrawal of the rejection of claims 38-48 as indefinite is respectfully requested.

Claims 38, 39, 41 and 46-48 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Otsuji as a primary reference in view of Maehara as a secondary reference and Fischer as a tertiary reference. The primary reference is said to disclose a shielding device 5 disposed between first and second core portions 3, 4 of a transformer. The primary reference is said to disclose the instant claimed invention except for the specific structure of the shielding device. The secondary reference is said to disclose the specific structure of the shielding device, with specific reference to paragraph 6 of the office action mailed April 23, 2003. It is said it would have been obvious to one having ordinary skill in the art at the time the invention was made to use the shielding design of the secondary reference in the primary reference for the purpose of providing electrical/conductive shielding. Regarding claim 40, the primary reference in view of the secondary reference is said to disclose the instant claimed invention except for the specific drain structure. The tertiary reference is said to disclose a shielding device, with specific reference to the previous office action mailed April 23, 2003, paragraph 8. It is said it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a drain wire connected to the shielding device of the primary reference as modified as said to be suggested by the tertiary reference for the purpose of providing better shielding for the

device. Regarding claims 42-45, the specific material used for the conductive layer/shield material/shielding device it is said would have been an obvious design consideration based on the intended application used and environment.

This ground of rejection is respectfully traversed. We rely on the authorities set forth on pages 15 and 16 of the response filed 27 October 2003.

According to the translation, the primary reference discloses a core 3 and a core 4 having identical shape, identical cross section, identical gap width and completely the same characteristics. The two cores are separated by a non-magnetic spacer 5 with a proper spacing and their gaps G are so arranged as to have symmetrical positions (opposite to each other by 180 deg.). That is not the disclosure of a shielding device for an electrical transformer having a first core portion and a second core portion with first and second windings on the first and second core portions respectively, the shielding device being located between the first core portion and the second core portion and constructed and arranged to electrically shield the first core portion from the second core portion as called for by the claims.

"A reference is only good for what it clearly and definitely discloses." *In re Hughes*, 145 U.S.P.Q. 467, 471 (C.C.P.A. 1965); *In re Moreton*, 129 U.S.P.Q. 227, 230 (C.C.P.A. 1961).

Manifestly, the primary reference does not disclose the shielding device located between the first core portion and the second core portion constructed and arranged to electrically shield the first core portion from the second core portion. And the secondary and tertiary references do not overcome the shortcomings of the primary reference.

Accordingly, withdrawal of the rejection of claims 38-48 as unpatentable over the primary, secondary and tertiary references is respectfully requested. If this ground of rejection is repeated, the Examiner is again respectfully requested to quote verbatim the language in each reference regarded as corresponding to each limitation in a rejected claim and quote verbatim the language in the references regarded as suggesting the desirability of combining what is there disclosed to meet the terms of the rejected claims.

What the Examiner has been doing is using the claims being rejected as a blueprint or template for attempting to read elements in the prior art upon the claims being rejected.

The alleged teaching is found, not in the references but in the claims being rejected. It is error to reconstruct the claimed invention from the prior art by using the rejected claim as a "blueprint." *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 548 (Fed. Cir. 1985).

> Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. [15] This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."[16] *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992).

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[15] *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). *See also Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).
[16] *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600.

A rejection based on Section 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the Examiner has the initial duty of supplying the factual basis for the rejection he advances. He may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *In re Warner*, 154 U.S.P.Q. 173, 178 (C.C.P.A. 1967). In the present case, it is impossible to combine the references to meet the terms of the claims being rejected.

In view of the foregoing amendments, authorities, those previously advanced, and the inability of the prior art, alone or in combination, to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe the application is not in a condition for allowance, he is respectfully requested to telephone the undersigned attorney at (617) 521-7014 to discuss what additional steps he believes are necessary to place the application in a condition for allowance.

No fees are believed to be due. However; the Office is authorized to apply any charges to deposit account 06-1050, Order No. 02103-415001.

Respectfully submitted,

FISH & RICHARDSON P.C.

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